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09/818,722	03/27/2001	Eric Flam	FLAM 2A	1331

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02/27/2004

Henry I. Schanzer, Esq.  
29 Brookfall Road  
Edison, NJ 08817

EXAMINER
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BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
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3764

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DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/818,722

Applicant(s)

Oliver Bodine et al

Examiner

Michael Brown

Group Art Unit

3764

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-90 is/are pending in the application.
- Of the above claim(s) 41-50, 51-64, 65-66, 77-78 and 83-86 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-20, 24-30, 32-40, 67-76 and 77-82 and 87-90 is/are rejected.
- ☒ Claim(s) 21-23 and 31 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Claim Objections*

Claims 6, 11-14, 40 and 67-76 are objected to because of the following informalities: In claims 6 and 11-14, the word "pad-like" is vague and indefinite. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

MB Claims 1-9, 11-20, 24-26, 28, 30, 33-40 67-72, 75-76 and 87-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Engelman. <sup>77-82</sup>

Engelman discloses in figures 5-6 a leg elevator that anticipates a prosthesis comprising a protective device (also claimed as a protective structure) 17, a hard outer shell 10. The pad is made of a soft material (foam), the pad is made in a semicircular shape and a means S1-S3 for securing. The pad extends beneath the foot and heel (fig. 6). The protective structure is shaped to be placed between a body part and a supporting surface. The (pad) protective device is fabricated of a firmness. The pad is fabricated of a material that enables tissue growth (foam) and dissolves over time.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 -10 are rejected under 35 U.S.C. 102(b) as being anticipated by Mercer.

Mercer discloses in figures 1-5 a cast that anticipates a prosthesis comprising a protective device 18, a rigid outer shell 14 and a rigid inner shell 16.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman.

Engelman discloses in figures 5-6 a leg elevator that anticipates a prosthesis, substantially as claimed. However, Engelman does not disclose the protective device being a rectangular shaped. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the protective device disclosed by Engelman could be rectangular shape because it is a design choice as to how the protective device is shaped. The protective device could also be oblong in shape.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman in view of Swartz.

Engelman discloses in figures 5-6 a leg elevator, that anticipates a prosthesis, substantially as claimed. However, Engelman does not disclose a layer between the

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user's skin and the outer surface of the pad. Swartz teaches in figure 2 a protective device comprising a breathable layer 14 that is located between a layer 16 and the outer skin of the user's foot. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the breathable layer that is between the user's skin and the lower layer as taught by Swartz could be incorporated into Engelman in order to have a layer between the user's skin and the protection device that would allow air to pass through from the pad to the user's skin.

Claims 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman in view of Suzuki.

Engelman discloses in figures 5-6 a leg elevator, that anticipates a prosthesis, substantially as claimed. However, Engelman does not disclose the pad including a fatty substance. Suzuki teaches in figure 1 a protective device comprising a fatty substance that includes a fatty substance that includes silicone (col. 6, lines 29-31). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the fatty substance including the silicone as taught by Suzuki could be incorporated into the device disclosed by Engelman in order to use the silicone to prevent fluids from being absorbed into the protection device.

#### ***Allowable Subject Matter***

Claims 21-23 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

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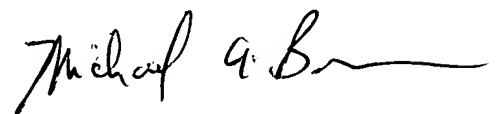
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Toth, Graebe and Walker, each discloses a protective device. Although each of these references discloses structural limitations recited in the claims, neither was used to reject any claims, in the first office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 703-308-2682. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 703-308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Brown  
February 23, 2004



MICHAEL A. BROWN  
PRIMARY EXAMINER